

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Dupont et al.
Appl. No.: 09/833,314
Conf. No.: 4353
Filed: April 10, 2001
Title: CANNED FILLED PET FOOD
Art Unit: 1761
Examiner: Steven L. Weinstein
Docket No.: 115808-239

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NON-COMPLIANT APPEAL BRIEF

Sir:

This Response is submitted in reply to the Notice of Non-Compliant Appeal Brief dated June 8, 2007.

REMARKS

In response to the Notice of Non-Compliant Appeal Brief dated June 8, 2007, Appellants have included citations to the specification by page, line number and reference numbers in the drawing to identify each of the limitations of each of the independent claims. The compliant version of the Appeal Brief is attached as Exhibit A without copies of the cited references, which were previously submitted.

Appellants submit that the present Appeal Brief is compliant under 37 CFR 41.37. Appellants respectfully request reconsideration of the Appeal Brief and submit that the Patent Office has failed to establish anticipation and a *prima facie* case of obviousness with respect to the rejections of the claimed invention. Accordingly, Appellants respectfully submit that the obviousness rejections are erroneous in law and in fact and should therefore be reversed.

The Director is authorized to charge any fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 115808-239 on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY _____

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Dated: June 12, 2007

EXHIBIT A

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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APPELLANTS' APPEAL BRIEF

Sir:

Appellants submit this Appeal Brief in support of the Notice of Appeal filed on December 11, 2006. This Appeal is taken from the Final Rejection in the Office Action dated September 20, 2006.

I. REAL PARTY IN INTEREST

The real party in interest for the above-identified patent application on Appeal is Nestec, S.A. by virtue of an Assignment dated July 5, 2001 and recorded at reel 011952, frame 0470 in the United States Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES

Appellants previously submitted an Appeal Brief in support of the Notice of Appeal filed on July 8, 2004. This former Appeal was taken from the Final Rejection in the Office Action dated February 9, 2004 and the Advisory Action dated June 8, 2004. The Patent Office sent a non-final Office Action dated January 4, 2005 that withdrew the Final Rejection dated February 9, 2004. Appellants submitted a Response to the non-final Office Action on April 4, 2005. The Patent Office mailed a Final Rejection in the Office Action dated July 13, 2005. Appellants submitted an Appeal Brief in support of the Notice of Appeal filed on October 13, 2005. This former Appeal was taken from the Final Rejection in the Office Action dated July 13, 2005. The Patent Office sent a non-final Office Action dated March 30, 2006 that withdrew the Final Rejection dated July 13, 2005. Appellants submitted a Response to the non-final Office Action on June 28, 2006. The Patent Office mailed a Final Rejection in the final Office Action dated September 20, 2006. This current Appeal is taken from the Final Rejection in the final Office Action dated September 20, 2006.

III. STATUS OF CLAIMS

Claims 1-17 are pending in the above-identified patent application. Claims 1-17 stand rejected. Therefore, Claims 1-17 are being appealed in this Brief. A copy of the appealed claims is included in the Claims Appendix.

IV. STATUS OF AMENDMENTS

A Final Office Action was mailed on September 20, 2006. In the Final Office Action, the Examiner maintained the obviousness rejections. Appellants filed a Notice of Appeal on December 11, 2006 in reply to the Final Office Action. A copy of the Final Office Action dated September 20, 2006 ("Final Office Action") is attached as Exhibit A in the Evidence Appendix.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A summary of the invention by way of reference to the drawings and specification for each of the independent and dependent claims is provided as follows:

Independent Claim 1 is directed to a canned pet food product having an upper end and a lower end (page 2, lines 7-8), the product comprising: an outer, tubular phase which is substantially solid and which extends from the lower end to the upper end and which includes an edible source of carbohydrate and proteins (page 2, lines 9-11); and a substantially cylindrical inner phase which extends from the lower end to the upper end of the outer phase and including an edible source of carbohydrate and protein (page 2, lines 12-14); the inner phase having an appearance different from the outer phase and extending within the outer phase (page 2, lines 15-19 and Figures 3-4).

Independent Claim 2 is directed to a canned pet food product having an upper end and a lower end (page 2, lines 7-8), the product comprising: an outer, tubular phase which is substantially solid and which extends from the lower end to the upper end and which includes an edible source of carbohydrate and protein (page 2, lines 9-11); and a substantially cylindrical inner phase which extends from the lower end to the upper end of the outer phase and including an edible source of carbohydrate and protein (page 2, lines 12-14); the inner phase having an appearance different from the outer phase (page 2, lines 15-19 and Figures 3-4); the product obtainable by a process comprising: filling the outer phase into a can (page 2, lines 30-31); forming a bore into the outer phase for providing a tubular outer phase (page 2, line 32); filling the inner phase into the bore of the tubular outer phase (page 2, lines 33-35); sealing the can (page 2, line 36); and retorting the sealed can (page 3, line 1).

Independent Claim 6 is directed to a canned pet food product having an upper end and a lower end (page 2, lines 7-8), the product comprising: an outer, tubular phase which extends from the lower end to the upper end and which includes a substantially solid, thermally gelled mixture of carbohydrate and protein (page 2, lines 9-11 and 20); and a substantially cylindrical inner phase which extends from the lower end to the upper end of the outer phase and which is in the form of chunks of a formulated emulsion product in a gravy (page 2, lines 12-14 and 21-23); the inner phase having an appearance different from the outer phase and extending within the outer phase (page 2, lines 15-19 and Figures 3-4).

Independent Claim 9 is directed to a process for producing a canned pet food product, the process comprising: filling into a can an outer phase including an edible source of carbohydrate and protein (page 2, lines 30-31); forming a bore into the outer phase for providing a tubular outer phase (page 2, line 32); filling a substantially cylindrical inner phase from a lower end to an upper end of the outer phase including an edible source of carbohydrate and protein into the bore of the tubular outer phase, the inner phase having an appearance different from the outer phase (page 2, lines 33-35); sealing the can (page 2, line 36); and retorting the sealed can (3, line 1).

Although specification citations are given in accordance with C.F.R. 1.192(c), these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the Brief. There is no intention to suggest in any way that the terms of the claims are limited to the examples in the specification. As demonstrated by the references numerals and citations, the claims are fully supported by the specification as required by law. However, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology as is done here to comply with rule 1.192(c) does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the references numerals and specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-17 are rejected under 35 U.S.C. § 103(a) over EP 769252 to Ohba ("*Ohba*") in view of GB 341,760 to Vickers ("*Vickers*") and WO 98/05219 to May ("*May*"), or vice versa, in further view of GB 1327351 to Quaker Oats ("*Quaker Oats*") and US Patent No. 3,738,847 to Bechtel ("*Bechtel*"), further in view of US Patent No. 2,421,199 to Gutmann ("*Gutmann*"), GB 2,194,125 to Froebel ("*Froebel*"), US Patent No. 2,937,095 to Zitin ("*Zitin*"), US Patent No. 3,385,712 to Dodge ("*Dodge*") and further in view of, GB 1486634 to Henkel ("*Henkel*"), WO 94/26606 to Mandanas ("*Mandanas*"), U.S. Patent No. 2,344,901 to Routh ("*Routh*"), GB 1583351 to McMahon ("*McMahon*"), EP 675046 to Errass ("*Errass*"), Australia 50797/96 to Hillebrand ("*Hillebrand*"), JP 59-31677 to QP Corp. I ("*QP Corp. I*") and JP 61-100174 to QP Corp. II ("*QP Corp. II*") further in view of applicants admission of the prior art, further in view of U.S. Patent No. 5,518,746 to Diaz ("*Diaz*"), JP 62-104566 to Hoashi ("*Hoashi*"), JP 59-159758 to Honma et al. ("*Honma*") and JP 57-12987 to Sonoya ("*Sonoya*"). Copies of each cited reference are attached herewith in the Evidence Appendix.

VII. ARGUMENT

A. LEGAL STANDARDS

Obviousness under 35 U.S.C. §103

The Federal Circuit has held that the legal determination of an obviousness rejection under 35 U.S.C. §103 is:

whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made...The foundational facts for the *prima facie* case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art...Moreover, objective indicia such as commercial success and long felt need are relevant to the determination of obviousness...Thus, each obviousness determination rests on its own facts.

In re Mayne, 41 U.S.P.Q. 2d 1451, 1453 (Fed. Cir. 1997).

In making this determination, the Patent Office has the initial burden of proving a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532; 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). This burden may only be overcome "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings." *In re Fine*, 837 F.2d 1071, 1074; 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 837 F.2d 1071; 5 U.S.P.Q.2d 1596. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091; 231 U.S.P.Q. 375 (Fed. Cir. 1986). Finally, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the

claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071.

Moreover, the Federal Circuit has held that “obvious to try” is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). “An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued.” *In re Eli Lilly & Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

Of course, references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed. Cir. 1986). “A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant.” *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Co., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998) (quoting *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994)).

Finally, the Court of Customs and Patent Appeals found that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims at issue *prima facie* obvious. *In re Ratti*, 270 F.2d 810; 123 U.S.P.Q. 349 (CCPA 1959).

B. THE CLAIMED INVENTION

Of the pending claims, Claims 1, 2, 6 and 9 are the sole independent claims. Claims 1, 2 and 6 each relate to a canned pet food product that has an upper end and a lower end. Claim 9 relates to a process for producing a canned pet food product. The canned pet food product defined in Claim 1 includes an outer tubular phase which is substantially solid and which extends from the lower end to the upper end and includes an edible source of carbohydrate and protein. The food product also has a substantially cylindrical inner phase that extends from the lower end

to the upper end of the outer phase and includes an edible source of carbohydrate and protein. The inner phase has an appearance that is different from the outer phase and extends within the outer phase.

Independent Claim 2 further defines the product as obtainable by a process that includes filling the outer phase into a can; forming a bore into the outer phase for providing a tubular outer phase; filling the inner phase into the bore of the tubular outer phase; sealing the can; and retorting the sealed can.

Independent Claim 6 includes the limitations of Claim 1 and further includes an outer, tubular phase that extends from the lower end to the upper end that contains a substantially solid, thermally gelled mixture of carbohydrate and protein; and a substantially cylindrical inner phase which extends from the lower end to the upper end of the outer phase. The inner phase is in the form of chunks of a formulated emulsion product in gravy and has an appearance different from the outer phase and extends within the outer phase.

The process defined in Claim 9 includes the steps of filling into a can an outer phase that has an edible source of carbohydrate and protein; forming a bore into the outer phase for providing a tubular outer phase; filling a substantially cylindrical inner phase from a lower end to an upper end of the outer phase that has an edible source of carbohydrate and protein into the bore of the tubular outer phase. Claim 9 also requires that the inner phase has an appearance different from the outer phase in addition to sealing the can and retorting the sealed can.

Appellants recognized the need for canned pet food products having new and interesting appearances to stimulate consumer interest. See, specification, page 2, lines 5-6. The pet food product, and processes for making it, have an attractive appearance formed by two or more discrete phases of different appearances, one within the other. Since the phases are substantially discrete, the product does not have the homogeneous appearance of conventional pet foods. Further, the pet food product of the invention is more suitable for packaging in taller cans in which the height of the can is at least as large as the diameter of the can because it is more easily removed from these cans than previously known products. See, specification, page 2, lines 15-19.

C. THE REJECTION OF CLAIMS 1-17 UNDER 35 U.S.C. §103(a) SHOULD BE REVERSED BECAUSE THE EXAMINER HAS NOT ESTABLISHED A *PRIMA FACIE* CASE OF OBVIOUSNESS

In the final Office Action at page 2, the Examiner alleges that the cited references render Claims 1-17 obvious. Appellants respectfully submit that the obviousness rejection of Claim 1-17 should be reversed because the Examiner failed to establish a *prima facie* case of obviousness. The Examiner failed to establish a *prima facie* case of obviousness in the rejection because there is no teaching or suggestion to combine the cited references to arrive at the present claims and, even if combinable, the cited references fail to disclose or suggest every element of the present claims.

1. One having ordinary skill in the art would not be motivated to combine the cited references to arrive at the present claims

Appellants respectfully submit that one having ordinary skill in the art would not be motivated to combine the cited references to arrive at the present claims because there exists no teaching or suggestion for combining the cited references to arrive at the present claims. Appellants first note that the way in which the rejection is phrased makes it difficult to address. The “or vice versa” language used in the rejection, along with the sheer number of references, makes the possible permutations of the rejections substantial. Moreover, because there is not a principal reference it is also difficult to respond. Appellants have attempted to set forth below why the references teach away from certain combinations and why the rejection does not allow Appellants to address every possible combination of the cited references.

Beginning with the *May* reference, which is entirely directed to a canned pet food product having two layers (a base and an upper layer). See, *May*, page 2, lines 11-19. *Quaker Oats* and *Bechtel* relate to a pet food of hash type that contains a center core of eggs completely surrounded (e.g. encased) by the meat mixture. *Quaker Oats*, col. 1, lines 12-15; and *Bechtel*, col. 2, lines 16-20. As a result, *Quaker Oats* and *Bechtel* teach away from the layered pet food product of *May* and thus, teach away from a combination of either reference with *May*.

Ohba relates to vertically and horizontally packed foods containing two or more packed food products. Similarly, *McMahon* discloses vertically packed foods with two liquid food

products. Further, the Examiner has cited five additional references, namely *Gutmann*, *Froebel*, *Zitin*, *Dodge* and *Vickers*, in support of *May*. None of these references even relates to canned products, and all but one do not even relate to pet food products.

Gutmann discloses a method of preserving eggs, particularly to a method in which the separated white and yolks of eggs are preserved in coagulated or hard-boiled condition. In this regard, the main object of *Gutmann* is to convert the eggs into a condition in which they can be easily and safely shipped and stored for an unlimited period of time. See, *Gutmann*, column 1, lines 1-8.

Froebel discloses dog treats which are primarily semi-moist products that are co-extruded and have a relatively hard outer skin, and thus are unsuitable for canning. See, *Froebel*, Examples 1-3. *Froebel* distinguishes different categories of pet food, most notably dry, wet and semi-moist as disclosed on page 1. With respect to canned pet foods, *Froebel* discloses various disadvantages, and further suggests that canned products are "unsuitable for use as treats." See, *Froebel*, page 1, line 56-57.

Zitin discloses a cheese core surrounded by meat encased in a casing. Col. 1, lines 15-19 The product is prepared by inserting a molding in a casing not a can with a liquid meat product, cooking the meat product, removing the mold and pouring molten cheese into the center and allowing it to solidify. See, *Zitin*, cols. 1 and 2. One skilled in the art would not be inclined to modify the horizontal arrangement (i.e., upper and base layers) of the *May* canned food product based on the teachings of *Zitin* directed to a vertical arrangement in a casing. In fact, such a combination would frustrate the teaching of *May* in that after opening the can and dispensing the pet food, what was the base layer becomes the upper layer. See, *May*, page 2, lines 20-25. Thus, *May* teaches away from the combination with *Zitin*.

Dodge relates to cooked egg rolls and unlike Appellants' canned invention is completely enclosed in a flexible, synthetic plastic. See, *Dodge*, col. 2, lines 29-34. The synthetic plastic outer wrapper can be either initially tube-like of a selected cross-section, or in the form of a strip that is formed into a tube-like form of a selected cross-section adjacent the extrusion nozzle. See, *Dodge*, col. 4, lines 4-7.

Moreover, like *Zitin*, *Dodge* relates to a food product with a vertical layer arrangement. Indeed, in *Dodge's* egg roll structure, the outer layer does not extend from the top end to the bottom end (see, *Dodge*, Figs. 1 and 2). This is due to packaging constraints such that the egg

yolk core can be seen in addition to the egg white portion (i.e., albumen) of the egg roll. In this regard, the primary purpose of *Dodge* is to produce a hard-cooked egg roll packaged in film which would represent enough convenience for both residential and commercial use (see, *Dodge*, col. 1, lines 32-42). As with *Zitin*, there is no motivation to combine or modify *May* with *Dodge* to obtain Appellants' invention.

Vickers relates to meat rolls (i.e., butchers meat, such as beef, veal, etc.) rather than canned pet food products, as required by the claimed invention (see, *Vickers*, col. 1, lines 11-16). The meat roll combines coarse particles and finer size particles in visually separate phases (see, *Vickers*, Figs. 1 and 2) which is said to improve taste (see *Vickers* at col. 1, line 53 to col. 2, line 63). There is no motivation to combine *Vickers* with *May*, where, in *May*, parallel superimposed layers are formed in contrast to an annular-type configuration disclosed in *Vickers*.

The remaining references do not even relate to food products, let alone pet food products. For example, *Henkel* merely relates to a cosmetic; *Mandanas*, like *Henkel*, has nothing to do with food, particularly pet foods, but merely relates to dispensing a viscous paste from containers, such as squeezable tubes; *Routh* merely relates to ice cream and products thereof; *Errass* merely relates to a condiment product that is dispensed from a tube; and the *QP Corp.* references relate to peanut butter and products thereof. Therefore, Appellants do not believe one skilled in the art would consider that references unrelated to pet food have any relevance with respect to the canned pet food product of *May*.

To arrive at the claimed invention, it is respectfully submitted that the Examiner has impermissibly used hindsight to piece together the cited art and has selectively picked and chosen teachings of each of the references in an attempt to explain what the claimed invention discloses. The Court of Appeals for the Federal Circuit has criticized this motivation to combine analysis as being "hindsight reconstructive" because the motivation to combine the references was first disclosed in the present invention. *In re O'Farrell*, 853 F.2d 894, 902-903 (Fed. Cir. 1988).

Further, the requisite prior art suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references and "the extent to which such suggestion must be explicit in . . . the references, is decided on the facts of each case, in light of the prior art and its relationship to the applicant's invention." 2-5 Chisum on Patents §5.04 (quoting *In re Gorman*, 933 F.2d 982, 986-87; 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir.

1991)). As has been clearly demonstrated herein above, most of the cited references do not even relate to food products, let alone pet food products. Therefore, there exists no reason why a skilled artisan, with no knowledge of the claimed invention, would have selected the prior art components for combination in the manner claimed. In fact, the number of references (17) relied on by the Examiner to support the present rejection is evidence by itself that the invention is not obvious.

Moreover, the Examiner asserts in the final Office Action dated September 20, 2006 at page 2, that Appellants' remarks filed June 28, 2006 (attached as Exhibit B) "do not address the art taken as a whole as to what the art taken as a whole teaches" because Appellants argue each reference separately. See, Office Action dated September 20, 2006, page 2. However, Appellants respectfully submit that each cited reference was discussed individually not to address the issue of novelty under 35 U.S.C. §102, but rather to illustrate, in part, the differences between the individual references and reasons why there exists no motivation to combine the references to render the present claims obvious under 35 U.S.C. §103. Furthermore, Appellants respectfully submit that it is the rejection itself that forced Appellants to respond in such a manner.

For at least the reasons discussed above, the combination of cited references is improper and, thus, fails to render the claimed subject matter obvious. Accordingly, Appellants respectfully submit that the obviousness rejections are improper and the cited references do not render the present claims obvious.

2. The cited references, either alone or in combination, fail to disclose or suggest all of the elements of the claimed invention

Appellants submit that the cited references, alone or in combination, fail to disclose or suggest every element of the present claims. As admitted in the Office Action dated June 3, 2003 (attached as Exhibit C) and the Office Action dated November 14, 2002 (attached as Exhibit D), the primary reference, *May*, fails to disclose or suggest the outer, tubular phase features required by the claimed invention.

For example, *May* fails to disclose or suggest an outer tubular phase which extends from the lower end to the upper end and an inner phase which extends from the lower end to the upper

end extending within the outer phase as required, in part, by the present claims. Instead, *May* discloses clearly defined upper and base layers such that, after opening the can and dispensing the pet food, what was the base layer becomes the upper layer (see, *May*, page 2, lines 20-25) rather than vertical layering as in the present invention. In fact, *May* goes on to reinforce that “[t]he cans produced by the process contain a product which comprises a lower layer made up of solid pieces of food in a thin sauce and having a substantially conical recess and an upper layer of a substantially solid foodstuff. The layers are clear and distinct...” *May*, page 9, lines 17-20. Therefore, *May* fails to teach or suggest an outer, tubular phase which extends from the lower end of the canned pet food product to the upper end of the canned pet food product as in the claimed invention.

The canned pet food of Appellants’ invention has the advantage of being suitable for use in larger cans where the height of the can is at least as large as the diameter of the can. See, specification, page 2, lines 1-19. In taller cans filled with a product like *May*’s, the upper and base layers would be more difficult to shake out into the pet’s bowl or dish. Based on at least these reasons, *May* is deficient with respect to the claimed invention.

The Examiner relies on sixteen other references that teach different cross-sectional shapes of products, many of which are unrelated to canned pet food, to support that it allegedly would have been obvious to use such cross-sectional shapes as a matter of choice or design. See, Office Action dated November 14, 2002, page 3. Accordingly, the Examiner relies on references that disclose a particular cross-sectional shape rather than the invention as a whole which includes an outer, tubular phase which extends from the lower end to the upper end of a canned pet food product and an inner phase which extends from the lower end to the upper end of the canned pet food product.

The Examiner relies on *Quaker Oats* and *Bechtel* in support of the deficiencies of *May* with respect to the outer and inner phases of the claimed invention. See, Office Action dated June 3, 2003. The primary focus of these references relates to a pet food of hash type that contains a center core of eggs. *Quaker Oats*, col. 1, lines 12-15; and *Bechtel*, col. 1, lines 34-36. But, nowhere do these references provide that the egg core extends from the top to the bottom of the can as do the inner and outer phases of the present invention. See, Figs. 1-8 of *Quaker Oats* and *Bechtel*. Instead, the egg core is completely encased within (e.g. completely surrounds) the

meat mixture. See, *Bechtel*, column 2, lines 16-20. Consequently, these references do not remedy the deficiencies of *May*.

Most of the remaining references relate to non-pet food products. As a result, they fail to disclose or suggest a pet food product or method of making same as required, in part, by the present claims. Moreover, the remaining references fail to disclose or suggest a pet food product having an outer tubular phase which extends from the lower end to the upper end and an inner phase which extends from the lower end to the upper end extending within the outer phase as required, in part, by the present claims

For example, *Ohba* relates to vertically and horizontally packed foods containing two or more packed food products. Similarly, *McMahon* discloses vertically packed foods with two liquid food products. Neither reference discloses an outer tubular phase which extends from the lower end to the upper end and an inner phase which extends from the lower end to the upper end extending within the outer phase. Thus, neither reference can remedy the deficiencies of *May*.

Gutmann discloses a method of preserving eggs, particularly to a method in which the separated white and yolks of eggs are preserved in coagulated or hard-boiled condition. In this regard, the main object of *Gutmann* is to convert the eggs into a condition in which they can be easily and safely shipped and stored for an unlimited period of time. See, *Gutmann*, column 1, lines 1-8.

Froebel discloses dog treats which are primarily semi-moist products that are co-extruded and have a relatively hard outer skin, and thus are unsuitable for canning. See, *Froebel*, Examples 1-3. *Froebel* distinguishes different categories of pet food, most notably dry, wet and semi-moist as disclosed on page 1. With respect to canned pet foods, *Froebel* discloses various disadvantages, and further suggests that canned products are "unsuitable for use as treats." See, *Froebel*, page 1, line 56-57.

Zitin discloses a cheese core surrounded by meat encased in a casing. Col. 1, lines 15-19. The product is prepared by inserting a molding in a casing not a can with a liquid meat product, cooking the meat product, removing the mold and pouring molten cheese into the center and allowing it to solidify. See, *Zitin*, cols. 1 and 2. With respect to Claim 1, *Zitin* fails to disclose a canned product, or a tubular phase, or an inner phase extending from the lower end to the upper end. With respect to Claim 2, *Zitin* also fails to disclose filling the outer phase into a can, sealing

a can and retorting the sealed can. With respect to Claim 6 *Zitin* also fails to disclose an outer phase that includes a substantially solid, thermally gelled mixture of carbohydrate and protein. Lastly, method Claim 9 of Appellants' invention is completely unrelated to *Zitin*.

Dodge relates to cooked egg rolls and unlike Appellants' invention is wrapped being completely enclosed in a flexible, synthetic plastic. See, *Dodge*, col. 2, lines 29-34. The synthetic plastic outer wrapper can be either initially tube like of a selected cross-section, or in the form of a strip that is formed into a tube like form of a selected cross-section adjacent the extrusion nozzle. See, *Dodge*, col. 4, lines 4-7.

Moreover, like *Zitin*, *Dodge* relates to a food product with a vertical layer arrangement. Indeed, in *Dodge's* egg roll structure, the outer layer does not extend from the top end to the bottom end (see, *Dodge*, Figs. 1 and 2) and thus fails to disclose or suggest the present claims. This is due to packaging constraints such that the egg yolk core can be seen in addition to the egg white portion (i.e., albumen) of the egg roll.

Vickers relates to meat rolls (i.e., butchers meat, such as beef, veal, etc.) rather than canned pet food products, as required by the claimed invention (see, *Vickers*, col. 1, lines 11-16). The meat roll combines course particles and finer size particles in visually separate phases (see, *Vickers*, Figs. 1 and 2) which is said to improve taste (see *Vickers* at col. 1, line 53 to col. 2, line 63).

The Examiner appears to rely on certain additional references in support of the position that the outer, tubular features of the claimed invention are an allegedly obvious matter of choice and/or design. Even if combinable, clearly these references are deficient with respect to the claimed invention as well. For example, *Henkel* merely relates to a cosmetic; *Mandanas*, like *Henkel*, has nothing to do with food, particularly pet foods, but merely relates to dispensing a viscous paste from containers, such as squeezable tubes; *Routh* merely relates to ice cream and products thereof; *Errass* merely relates to a condiment product that is dispensed from a tube; and the *QP Corp. I and II* references relate to peanut butter and products thereof. Consequently, they fail to disclose or suggest a pet food product or method of making same as required, in part, by the present claims. Moreover, these references fail to disclose or suggest a pet food product having an outer tubular phase which extends from the lower end to the upper end and an inner phase which extends from the lower end to the upper end extending within the outer phase as required, in part, by the present claims.

For the reasons discussed above, the combination of the cited references is improper. Moreover, even if combinable, the cited references do not teach, suggest, or even disclose all of the elements of Claims 1-17, and thus, fail to render the claimed subject matter obvious for at least these reasons. Therefore, for the reasons discussed above, Appellants respectfully submit that Claims 1-17 are novel, nonobvious and distinguishable from the cited references and are in condition for allowance.

VIII. CONCLUSION

Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103 with respect to the rejections of Claims 1-17. Accordingly, Appellants respectfully submit that the obviousness rejections are erroneous in law and in fact and should therefore be reversed by this Board.

The Director is authorized to charge \$500 for the Appeal Brief and any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 115808-239 on the account statement.

Respectfully submitted,

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BY 

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Dated: June 12, 2007

CLAIMS APPENDIX

PENDING CLAIMS ON APPEAL OF U.S. PATENT APPLICATION SERIAL NO. 09/833,314

1. A canned pet food product having an upper end and a lower end, the product comprising:

an outer, tubular phase which is substantially solid and which extends from the lower end to the upper end and which includes an edible source of carbohydrate and proteins; and

a substantially cylindrical inner phase which extends from the lower end to the upper end of the outer phase and including an edible source of carbohydrate and protein; the inner phase having an appearance different from the outer phase and extending within the outer phase.

2. A canned pet food product having an upper end and a lower end, the product comprising:

an outer, tubular phase which is substantially solid and which extends from the lower end to the upper end and which includes an edible source of carbohydrate and protein; and

a substantially cylindrical inner phase which extends from the lower end to the upper end of the outer phase and including an edible source of carbohydrate and protein; the inner phase having an appearance different from the outer phase;

the product obtainable by a process comprising:

filling the outer phase into a can;

forming a bore into the outer phase for providing a tubular outer phase;

filling the inner phase into the bore of the tubular outer phase;

sealing the can; and

retorting the sealed can.

3. The canned pet food product according to claim 1 in which the outer phase is a thermally gelled mixture.

4. The canned pet food product according to claim 1 in which the inner phase comprises chunks of a formulated emulsion product in a gravy.

5. The canned pet food product according to claim 1 in which the outer phase comprises about 25% to about 75% by volume of the product and the inner phase comprises about 25% to about 75% by volume of the product.

6. A canned pet food product having an upper end and a lower end, the product comprising:

an outer, tubular phase which extends from the lower end to the upper end and which includes a substantially solid, thermally gelled mixture of carbohydrate and protein; and

a substantially cylindrical inner phase which extends from the lower end to the upper end of the outer phase and which is in the form of chunks of a formulated emulsion product in a gravy; the inner phase having an appearance different from the outer phase and extending within the outer phase.

7. The canned pet food product according to claim 1 in which the product has a height at least as large as its diameter.

8. The canned pet food product according to claim 1 in which the phases each have a moisture content of about 70% to about 85% by weight.

9. A process for producing a canned pet food product, the process comprising:
filling into a can an outer phase including an edible source of carbohydrate and protein;
forming a bore into the outer phase for providing a tubular outer phase;
filling a substantially cylindrical inner phase from a lower end to an upper end of the outer phase including an edible source of carbohydrate and protein into the bore of the tubular outer phase, the inner phase having an appearance different from the outer phase;
sealing the can; and
retorting the sealed can.
10. A process according to claim 9 in which the phases each have a viscosity of about 1500 cp to about 3500 cp when filled into the can.
11. The canned pet food product according to claim 2 in which the outer phase is a thermally gelled mixture.
12. The canned pet food product according to claim 2 in which the inner phase comprises chunks of a formulated emulsion product in a gravy.
13. The canned pet food product according to claim 2 in which the outer phase comprises about 25% to about 75% by volume of the product and the inner phase comprises about 25% to about 75% by volume of the product.
14. The canned pet food product according to claim 2 in which the product has a height at least as large as its diameter.
15. The canned pet food product according to claim 1 in which the phases each have a moisture content of about 70% to about 85% by weight.
16. The canned pet food product according to claim 1 in which the product has a height at least as large as its diameter.

17. The canned pet food product according to claim 1 in which the phases each have a moisture content of about 70% to about 85% by weight.

EVIDENCE APPENDIX

- EXHIBIT A: Office Action dated September 20, 2006
- EXHIBIT B: Appellants' Response to Non-Final Office Action filed June 28, 2006
- EXHIBIT C: Office Action dated June 3, 2003
- EXHIBIT D: Office Action dated November 14, 2002
- EXHIBIT E: WO 98/05219 to May ("*May*"), cited by the Examiner in the Office Action dated July 13, 2005
- EXHIBIT F: GB 1327351 to Quaker Oats ("*Quaker Oats*"), cited by the Examiner in the Office Action dated July 13, 2005
- EXHIBIT G: US Patent No. 3,738,847 to Bechtel ("*Bechtel*"), cited by the Examiner in the Office Action dated July 13, 2005
- EXHIBIT H: US Patent No. 2,421,199 to Gutmann ("*Gutmann*"), cited by the Examiner in the Office Action dated July 13, 2005
- EXHIBIT I: GB 2,194,125 to Froebel ("*Froebel*"), cited by the Examiner in the Office Action dated July 13, 2005
- EXHIBIT J: US Patent No. 2,937,095 to Zitin ("*Zitin*"), cited by the Examiner in the Office Action dated July 13, 2005
- EXHIBIT K: US Patent No. 3,385,712 to Dodge ("*Dodge*"), cited by the Examiner in the Office Action dated July 13, 2005
- EXHIBIT L: GB 341,760 to Vickers ("*Vickers*"), cited by the Examiner in the Office Action dated July 13, 2005
- EXHIBIT M: EP 769252 to Ohba ("*Ohba*"), cited by the Examiner in the Office Action dated July 13, 2005
- EXHIBIT N: GB 1486634 to Henkel ("*Henkel*"), cited by the Examiner in the Office Action dated July 13, 2005
- EXHIBIT O: WO 94/26606 to Mandanas ("*Mandanas*"), cited by the Examiner in the Office Action dated July 13, 2005
- EXHIBIT P: U.S. Patent No. 2,344,901 to Routh ("*Routh*") , cited by the Examiner in the Office Action dated July 13, 2005
- EXHIBIT Q: GB 1583351 to McMahon ("*McMahon*"), cited by the Examiner in the Office Action dated July 13, 2005

EXHIBIT R: EP 675046 to Erras ("*Erras*"), cited by the Examiner in the Office Action dated July 13, 2005

EXHIBIT S: Australia 50797/96 to Hillebrand ("*Hillebrand*"), cited by the Examiner in the Office Action dated July 13, 2005

EXHIBIT T: JP 59-31677 to QP Corp. I ("*QP Corp. I*"), cited by the Examiner in the Office Action dated July 13, 2005

EXHIBIT U: JP 61-100174 to QP Corp. II ("*QP Corp. II*"), cited by the Examiner in the Office Action dated July 13, 2005

RELATED PROCEEDINGS APPENDIX

None.